

REMARKS

The Examiner rejected Claims 2-4 on formal grounds, Claims 1, 4, 5, 8 and 9 under 35 U.S.C. 102 as anticipated by Schroeder, Claims 1 and 2 under 35 U.S.C. 102 as being anticipated by Poinneau et al., Claim 6 under 35 U.S.C. as being unpatentable over Schroeder in view of Arcand and Claim 7 under 35 U.S.C. 103 as being unpatentable over Schroeder in view of Poinneau et al.

In order to expedite the prosecution of the subject patent application, prior Claims 1-9 have been cancelled without prejudice or disclaimer and Claim 10 has been added to more patentably distinguish over the cited prior art.

Of the three cited references, only Schroeder was cited against prior Claims 4, 8 and 9 which were directed to, in combination, the feature or steps of a casing with a metal side to retain the magnet's attracting side to the metal side of the casing. The Examiner uses an inherency argument in applying Schroeder against prior Claims 4, 8 and 9 (see page 2, last three lines and top two lines of page 3 "...said metal casing dimensioned to inherently receive said attracting side of said magnet so that said magnet can be retained in a fixed position relative to said metal side of said casing when said attracting side of said magnet is brought into proximity with said metal side of said casing (Figure 5 and 6) (Abstract)."

 (emphasis

added)

New Claim 10 (which is related to prior Claims 4, 8 and 9) that is submitted herewith more patentably distinguishes over the cited prior art including the Schroeder reference. Neither Figures 5 or 6 nor the Abstract nor any other portion of the cited Schroeder reference discuss, teach, suggest or disclose placing the magnet against a metal side of a tape containing casing as more patentably defined in sole method Claim 10. This inherency type argument was rejected by the Federal Circuit Court of Appeals in the case *In re Weiss* 989 Fed 1202 (1993). Furthermore, the configuration of the Schroeder magnet gripping head 26 located within its housing 34 would appear to make it very difficult at least and probably not very possible to attach the housing 34 with its interior magnet gripping head 26 to a metal side of a tape containing casing. Finally, the Examiner's attention is respectfully directed to the following portions of the Schroeder patent (see Column 3, lines 41-43, and Column 6, lines 14-16 wherein it is clear that the magnetic gripping head 26 of Schroeder is to be "carried in a pocket, in a toolbox, or on a toolbelt", but not as an attachment to a metal side of a casing as presently claimed in new Claim 10.

New Claim 10 more patentably distinguishes over Schroeder by the second and fifth method step paragraphs (in combination

with the other steps) relating to attaching the magnet to a metal side of the casing which is not taught, suggested or disclosed by Schroeder or the other references cited by the Examiner.

Accordingly, the allowance of the sole remaining Claim 10 over the art cited by the Examiner is respectfully solicited.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account No. 23-0830.

Respectfully submitted,



Harry M. Weiss
Reg. No. 19,497
cell phone 1-702-528-7222
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